



Paper No. 7

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JUN 24 2002

OFFICE OF PETITIONS

In re Application of	:	
William Martin	:	
Application No. 09/891,945	:	DECISION REFUSING STATUS
Filed: June 26, 2001	:	UNDER 37 CFR \$1.47(b)
Title: TRADE ALLOCATION	:	

This is in response to the petition under 37 CFR \$1.47(b), filed March 5, 2002 (certificate of mailing February 8, 2002).

The petition under 37 CFR \$1.47(b) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR \$1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR \$1.136(a).

The above-identified application was filed on June 26, 2001, without an executed oath or declaration and naming William Martin, Matt Smith and Susan Estes as joint inventors. Accordingly, on August 16, 2001, applicants were mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration, and a surcharge for late filing. This Notice set a period for reply of two months, with extensions of time obtainable under \$1.136(a).

With the instant petition, petitioner submitted an unexecuted declaration identifying William Martin as the sole inventor, and paid the surcharge for late filing. To make the reply time, the petition was accompanied by a petition for extension for response within the fourth month (and fee). A declaration signed by less than all of the inventors is not a proper reply to the Notice of Missing Parts, except as provided for in §§ 1.42, 1.43, 1.47, or 1.67. Applicant maintains that status under 37 CFR \$1.47(b) is proper because the proper inventive entity is sole inventor, William Martin, and inventor Martin has refused to execute the declaration. In support thereof, petitioner submits the declaration of patent paralegal Melissa Scanzillo.

\$1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who

otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

Accordingly, a grantable petition under 37 CFR §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP §409.03(g).

See 35 U.S.C. §118; 37 C.F.R. §1.47; §§409.03 and 605 of the *Manual of Patent Examining Procedure* (8th ed) (Rev. 1, Aug. 2001) (MPEP).

The instant petition lacks requirements (1), (2), (3), (6) and (7):

As to items (1) and (2),

The declaration submitted is not executed by anyone on behalf of inventor Martin. The petition does not make clear who is making application for patent on behalf of inventor Martin (i.e. who is the rule 47(b) applicant). A declaration for patent offered pursuant to §1.47(b) must be properly executed by the rule 47(b) applicant.

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the

attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP §324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. Staeger v. Commissioner, 189 USPQ 272 (D.D.C. 1976), In re Striker, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the non-signing inventor. See MPEP 409.03(b).

As to item (3),

Petitioner submits the declaration of patent paralegal Scanzillo with supporting exhibits to show refusal on the part of inventor Martin to join in the application.

This declaration is not sufficient to show refusal. See MPEP 409.03(d). Petitioner has not thereby shown that inventor Martin, by his conduct, has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The declaration and supporting documentation only support a conclusion that the PCT power of attorney, combined declaration and power of attorney, and assignment were sent to inventor Martin. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Martin and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Additionally, on the instant evidence, a conclusion that inventor Martin's failure to respond constitutes refusal cannot be inferred. The evidence does not support a conclusion that inventor Martin received the messages and the letters and thus, has by his conduct refused to join in the application. Petitioner has not provided copies of signed Federal Express receipts to show that inventor Martin received the declaration. Nor does petitioner provide evidence of conversations or E-mail

communications in which inventor Martin acknowledges receipt of any application papers (or states his refusal to join in the application).

On renewed petition, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Thus, on renewed petition, a new declaration of facts from Ms. Scanzillo or other proper party, such as the person(s) who presents the application papers and/or the person(s) who is the recipient of any oral or written refusal, is required.

As to item (6),

Rule 47(b) applicant must prove that, as of the date the application was deposited in the United States Patent and Trademark Office, (a) the invention had been assigned to the applicant, or (b) the inventor had agreed in writing to assign the invention to the applicant, or (c) the applicant otherwise had sufficient proprietary interest in the subject matter to justify filing of the application.

If inventor Martin agreed in writing to assign the invention described in this application and deposited pursuant to 37 C.F.R. §1.47(b), a copy of that agreement should be submitted. If the invention has not been assigned, or if there is no written agreement to assign, the rule 47 applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter. A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state or foreign) would by the weight of the authority in the jurisdiction award title of the invention to the rule 47 applicant. The facts in support of any conclusion that a court would award title to the rule 47 applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patent Quarterly) relied on to demonstrate a proprietary interest should be made of record. See MPEP 409.03(f).

As to item (7),

Petitioner makes no assertion. On request for reconsideration, rule 47 applicant must submit proof of irreparable damage. See MPEP §409.03(g).

On Request for Reconsideration, to avoid abandonment and attain 1.47 status, applicant must correct the noted deficiencies and provide a 1.47 petition in compliance with all applicable law.

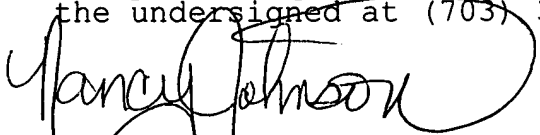
Further correspondence with respect to this matter should be addressed as follows:

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By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.



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